

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the previous amendments and the following remarks.

Claim 1 is rejected as being unpatentable over U.S. Patent No. 6,508,806, hereinafter Hoste, in view of U.S. Patent No. 4,925,448, hereinafter Bazaral, and U.S. Patent No. 5,501,341, hereinafter Van Es.

Hoste discloses a catheter with wire reinforcement.

The Official Action takes the position that Hoste discloses a catheter as recited, and that it would have been obvious to an ordinarily skilled artisan to have packaged Hoste's catheter in a catheter package as recited in view of the disclosures in Bazaral and Van Es. Applicants respectfully disagree.

Bazaral discloses a package for packaging a catheter without wire reinforcement, i.e., a catheter that is not susceptible to plastic deformation, entirely in a curled state. Bazaral's teaching with respect to packaging catheters in a curled state is relevant only to catheters without wire reinforcement. Indeed, as evidenced by Van Es, which discloses a catheter having wire reinforcement packaged entirely in its natural state, catheters having wire reinforcement were, in the prior art, instead packaged entirely in their natural state.

The Examiner states that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to enclose the proximal half of Hoste in a plastic compartment/tray as disclosed by Bazaral to keep the distal portion protected from microorganisms and particles while the proximal portion is being attached to the appropriate machines." However, assuming some basis exists for the Examiner's statement here, an ordinarily skilled artisan would have been

motivated to do no more than enclose the proximal half of Hoste's catheter in a plastic compartment/tray-- there is nothing in the Examiner's statement of motivation to explain why an ordinarily skilled artisan would have also packaged the proximal half of Hoste's catheter in a curled state. Indeed, as discussed above, the prior art teaches away from packaging any portion of a catheter having wire reinforcement in a curled state.

Applicants furthermore submit that it is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. See *In Re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed Cir. 1992). Moreover, it is impermissible to simply engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. See *In Re Gorman*, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991); *In Re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007). Applicants respectfully submit that the Examiner has impermissibly used the claimed invention as a template and relied upon *ex post* reasoning to combine bits and pieces of Hoste, Bazaral and Van Es in an attempt to arrive at the invention of claim 1. The Final Office Action does not provide any articulated reasoning with a rational underpinning that would have prompted a person of ordinary skill in the art to combine the catheter of Hoste with a portion of Bazaral's catheter package at one end of Hoste's catheter, and a portion of Van Es's

catheter package at the other end of Hoste's catheter, absent knowledge of Appellant's disclosure. See *KSR* at 1741.

Accordingly, neither Hoste, Bazaral or Van Es, alone or in combination, discloses, teaches or suggests a catheter package packaging a catheter including a catheter body having a distal portion and a proximal portion, a tube wall defining a lumen passing through from the distal portion to the proximal portion and a metal reinforce member embedded in the tube wall, and a connector part fixed to the proximal portion of the catheter body, wherein the catheter package holds the distal portion of the catheter of 10 to 50 cm in length in a natural state with no external force exerted thereon, and the catheter package holds the remaining proximal side of the catheter in a curled state with a curvature diameter of 10 to 50 cm, wherein the catheter is highly susceptible to plastic deformation and maintains a predetermined curved shape in the natural state at the distal portion, as recited in amended Claim 1.

Claim 1 is therefore allowable over Hoste in view of Bazaral and Van Es, and withdrawal of the rejection of Claim 1 is respectfully requested.

Claim 10 is also rejected as being unpatentable over Hoste in view Bazaral and Van Es.

Amended Claim 10 recites a catheter packaged in a catheter package, the catheter package including a bottom and upstanding sidewalls, the catheter including a catheter body having a distal portion and a proximal portion, a tube wall defining a lumen passing through from the distal portion to the proximal portion and a metal reinforce member embedded in the tube wall, and a connector part fixed to the proximal portion of the catheter body, the catheter package holding the distal portion of the catheter of 10 to 50 cm in length in a natural state with no external force

exerted thereon, the catheter package holding the remaining proximal side of the catheter in a curled state with a curvature diameter of 10 to 50 cm, the catheter being highly susceptible to plastic deformation and maintaining a predetermined curved shape in the natural state at the distal portion.

Amended Claim 10 is allowable over Hoste, Bazaral and Van Es for reasons consistent with the above discussion of Claim 1. Withdrawal of the rejection of Claim 10 is therefore also respectfully requested.

The dependent claims are allowable at least by virtue of their dependence from allowable independent claims. The dependent claims also recite further distinguishing aspects of the catheter and catheter package at issue here. For example, amended Claim 5 recites that the catheter is held in the state of astride over two trays removably integrated with each other, and amended Claim 11 recites that the catheter package comprises a plurality of independent trays, an upstanding sidewall of one of the plurality of trays being in back-to-back relationship with an upstanding sidewall of another of the plurality of trays.

Early and favorable action with respect to this application is respectfully requested.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful

in resolving any remaining issues pertaining to this application the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: May 4, 2009

By: Peter T. DeVore
Matthew L. Schneider
Registration No. 32814

Peter T. DeVore
Registration No. 60361

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620